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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,994

09/22/2006

Satoshi Tanabe

442P105

3238

42754 7590  
Nields & Lemack  
176 E. Main Street  
Suite #5  
Westboro, MA 01581

08/14/2008

EXAMINER

KLINKEL, KORTNEY L

ART UNIT

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1615

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,994	<b>Applicant(s)</b> TANABE ET AL.	
	<b>Examiner</b> Kortney Klinkel	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/6/2008 and 6/25/2008</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Application***

Receipt is acknowledged of remarks and amendments filed June 6, 2008.

Claims 1 and 7 were amended.

Claims 1-18 are under consideration in the instant Office Action.

### ***Information Disclosure Statement***

Acknowledgement is made of applicant's submitting an information disclosure statement on June 6, 2008 and June 25, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

See attached copies of PTO-1449.

### ***Terminal Disclaimer***

Acknowledgement of the receipt of the terminal disclaimer filed on June 6, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending application serial number 10/593920 is made. However, at the time of the instant Office action, the terminal disclaimer has yet to be reviewed. Therefore the rejection of claims 1-7 under Double Patenting is maintained.

All rejections/objections not addressed herein have been withdrawn.

### ***Response to Arguments***

#### **Rejection of claims 1-7 under 35 USC § 102(a)**

Applicant's arguments, see page 2, filed 6/6/2008, with respect to the rejection of claims 1-7 under 35 USC § 102(a) as being anticipated by Tanabe et al. JP2003146810 have been fully considered but they are not persuasive. Please note that in the Office action dated 3/5/2008, Examiner inadvertently left out the "4" from the JP document serial number.

Applicant's argue that the rejection was made under 35 USC § 102(b), however, as per the Office action dated 3/5/2008, the rejection was properly made under 35 USC § 102(a). Applicants further argue that rejection under 35 USC § 102(a) is not proper because the inventors of the instant application and JP2003146810 are the same and therefore does not constitute "by another". This argument is not found persuasive because whereas inventors Hotta, Toya and Hosoda are the same, inventor Tanabe is not. In the instant application Satoshi Tanabe is the inventor and in JP2003146810, Tomotsugu Tanabe is the inventor. Therefore the rejection is maintained.

#### **Rejection of claims 1-7 under 35 USC § 102(b)**

Applicant's arguments, see pages 2-4 filed 6/6/2008, with respect to the rejection of claims 1-7 under 35 USC § 102(b) as being anticipated by Hotta et al. JP6092935 have been fully considered but they are not persuasive.

Applicant's amended claim 1 to recite "a flea control agent comprising a flea-killing effective amount of an N-substituted indole derivative." Applicant's argue that Hotta specifically describe only that the indole derivatives were effective in controlling nilaparvata lunge-ns belonging to Hemiptera and plutella xylostella belonging to Lepidoptera, which are completely different than fleas. Whereas it is true that Hotta does stated that the N-substituted indole derivatives are useful in controlling the organisms nilaparvata lunge-ns belonging to Hemiptera and plutella xylostella belonging to Lepidoptera as argued by Applicants, these organisms, are not, however, the only organisms recited by Hotta. As stated in the Office action dated 3/5/2008, Hotta also teaches that the instant N-substituted indoles of formula (I) are useful in controlling fleas (paragraph 0029 of the machine translation). *Xenopsylla cheopis* (rat flea) and *Ctenocephalides canis* (dog flea) are two of the types of fleas controlled by the N-substituted indoles. Paragraphs [0024]-[0034] illustrate several other organisms that the N-substituted indoles are useful in controlling. Hotta demonstrates the non-discriminatory effect of the N-substituted indoles. These molecules are effective against a wide range of insects, worms and nematodes.

Applicant further argues that Hotta, despite teaching in paragraph [0001] that the N-substituted indoles can be used in order to protect a man or an animal from parasitic hindrance and teaching in paragraph [0029] that the parasitic hindrance can be fleas,

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fails to describe fleas as the insect pests. This argument is contradictory and is therefore not persuasive.

Applicant argues that instant Examples 4 and 5 are drawn to the controlling effects of the indole derivative on cat fleas which is neither taught nor suggested by Hotta. Further applicant states that the specification states that the present invention is based on the new finding that the N-substituted indole derivative has low toxicity to animals. These arguments are moot because cat fleas and their control are never discussed in the instant claims. Furthermore, the instant claims are drawn to a composition, so it is superfluous whether or not the indole derivatives are of low toxicity to animals.

Applicant's final argument alleges that Hotta does not disclose a shampoo or rinse or a percutaneous preparation comprising liquid drops for controlling fleas. This argument is found partially persuasive and therefore the rejection of claims 6, the shampoo or rinse under 35 USC § 102(b) has been withdrawn.

Hotta teaches that the indole derivatives can be mixed with a liquid carrier, an emulsifier, a dispersant, or a disintegrator among other excipients (paragraphs [0017]-[0019]). The amendment which added the phrase "a percutaneous preparation..." is an intended use and it is the position of the examiner that the liquid composition of Hotta could be used percutaneously. The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

However Hotta clearly teaches a composition of the instant N-substituted indole derivatives which is useful in against controlling fleas and thus the rejection of claims 1-5 under 35 USC § 102(b) is still deemed proper and is thus maintained.

### ***New Claim Rejections***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotta et al. (JP6092935, all references to which are in regard to the machine translation).

Hotta teaches that the indole derivates can be mixed with a liquid carrier, an emulsifier, a dispersant, or a disintegrator among other excipients (paragraphs [0017]-[0019]). The amendment which added the phrase “a percutaneous preparation...” is an intended use and it is the position of the examiner that the liquid composition of Hotta could be used percutaneously. The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotta et al. (JP6092935, all references to which are in regard to the machine translation).



Hotta teaches a composition comprising N-substituted indole derivatives identical to those of the instant invention and their use as an insecticide in order to protect man or animal from parasitic hindrance ([0001]).

With respect to claims 6 and 8 which recite a shampoo or rinse for controlling fleas, Hotta teaches that the N-substituted indole derivatives can be diluted with water and used as needed. Hotta also teaches that the indole derivatives can be mixed with a liquid carrier, an emulsifier, a dispersant, or a disintegrator among other excipients (paragraphs [0017]-[0019]).

Hotta does not explicitly teach the use of the N-substituted indoles as a shampoo, however, as alluded to above, Hotta describes that the indole derivatives can be mixed with an emulsifier. Emulsifiers such as surface-active agents are the major functional component of shampoos. As such, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to arrive at the instant compositions comprising N-substituted indoles with a reasonable expectation for success.

### ***Conclusion***

Claims 1-9 are rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel, Ph.D. whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached at (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615